

### **REMARKS/ARGUMENTS**

Claims 1, 4-14 and 17-33 are pending in the present application. In the Office Action mailed September 16, 2005, the Examiner rejected claims 23-30 and 33 under 35 U.S.C. § 112. The Examiner also rejected claims 1, 4-14 and 17-33 under 35 U.S.C. § 103.

By this paper, Applicants respond to the above-recited rejections and add new claim 34. In light of the above-recited amendments and the following remarks, reconsideration and allowance of the pending claims is respectfully requested.

#### **I. Claims 23-30 and 33 Rejected Under 35 U.S.C. § 112**

The Examiner rejected claims 23-30 and 33 under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner stated that these are “system claims” and as such, the phrase “implement a method that comprises” needs to be deleted. Office Action, p. 2. Applicants have deleted this phrase as requested. Accordingly, withdrawal of this rejection is respectfully requested.

#### **II. Rejection of Claims 1, 4-14 and 17-33 Under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1, 4-14 and 17-33 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,640,317 to Snow (hereinafter, “Snow”). This rejection is respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the

references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that independent claims 1, 14 and 23 are patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims. Contrary to the Examiner's assertions, Snow does not satisfy the limitation of "continuously examining the system calls to determine whether such system calls are executed properly."

It should first be noted that, in the prior Office Action response, Applicants argued that Snow did not teach the step of "examining" the system calls. However, in response to this argument, the Examiner rejected this argument on grounds that this step was

not recited in the rejected claim. Although the claims is [sic] interpreted in light of the specification, limitations from the specification is [sic] not read into the claims."

Office Action, dated 4/21/2005, p. 3.

In response to this position set forth by the Examiner, Applicants, in their next submission, amended independent claims 1, 14 and 23 to affirmatively include the step "continuously examining the system calls to determine whether such system calls are executed properly." In response to this claim amendment, the Examiner acknowledges that **"Snow does not explicitly teach... [the limitation of] continuously examining the system calls to determine whether such system calls are executed properly."** Office Action, p. 4 (emphasis added). However, despite this acknowledgment, the Examiner still rejects the present claims on grounds that Snow teaches the "capabilities of"

continuously detecting and restoring computer data to a proper condition as well as comparing changes, responding to changes, resolving conflicts, and adjusting environmental variables for application to be properly performed capabilities do perform such Applicant's continuously examining the system calls to determine

whether such system calls are executed properly limitation. This is because Snow *clearly applied these capabilities for checking, monitoring, tracking (i.e., examining) system calls or connections in determining whether the system functioned properly.*

Office Action, p. 5 (bold removed and italics added).

As best understood, the Examiner is apparently stating that Snow's capability of (1) detecting and restoring computer data, (2) comparing changes, responding to changes, (3) resolving conflicts, and (4) adjusting to environmental variables inherently would involve examining system calls to determine if such calls were executed properly. (Clearly the Examiner is not asserting that such disclosure expressly satisfies this limitation as the Examiner has already acknowledged, as noted above, that this limitation is not "explicitly" taught by Snow.) However, in order to establish that a claim limitation is "inherent" in a prior art reference, the MPEP explains that

"...the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).... "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

MPEP § 2112 (IV). In other words, the Examiner must show that the missing claim limitation is "necessarily" present in Snow, not that such a limitation is possible, probably, or may result from a given disclosure in the prior art. *See e.g., Robertson*, 169 F.3d at 745, 49 USPQ2d at 1950-51.

Applicants do not believe that the Examiner has or cannot meet this high standard for inherent disclosure of the limitations found in independent claims 1, 14, and 23. All the Examiner has done in the present case is to conclude that because Snow has a system that can detect changes,

respond to changes, resolve conflicts, etc. it must be able to monitor system calls.<sup>1</sup> Such a “conclusion” is not justified and will not be “necessarily” present in Snow (as is required to show inherency). On the contrary, there are a variety of different mechanisms for monitoring a computer system and detecting problems in an application without the use of system call. In fact, Snow teaches a different system and protocol that it uses to detect problems/conflicts in the computer system. Snow’s system is devoted to a new computer topology in which each application is separated into “encapsulated working definitions” and a “runtime representation.” Col. 5, lines 36-47. Using this topology, Snow teaches that a damage detection and repair facility (“DDRF”) will then monitor the application by comparing the runtime representations with the working constraints. In other words, the DDRF “compares the change [*i.e.*, any change made to the runtime representation] against the constraints as defined by the set of working definitions in the computer system” to determine “whether the changes create[] any conflict” with the working definitions. Col. 10, lines 10-13; Figure 7. The existence of such a “conflict” means that the application has been damaged and needs to be repaired. *See id.* Accordingly, the DDRF will then resolve these conflicts by “repairing the damaged file, installing a missing driver, or adjusting an environmental variable”

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<sup>1</sup> In fact, Applicants strongly disagree with the Examiner’s position that Snow teaches a system that will continuously monitor system calls made by an application. The Examiner believes that Col. 9, line 59 through Col. 10, line 36 teaches this limitation. However, in this cited portion, Snow describes in detail Figure 7 and teaches that the “damage detection and repair facility monitors the computer system for changes” by comparing the runtime representation of the application with the established set of working definitions. Again, there is nothing in this section that discusses system calls or that such calls are being monitored continuously or that such a teaching is “inherent” or necessarily found in Snow.

Likewise, Applicants also dispute that Snow’s system does any sort of monitoring “continuously.” For example, the Examiner asserts that Col. 2, lines 44-46 teaches that Snow’s system can “continuously detect and restore computer data.” However, this section of Snow teaches that the system can “automatically detect damaged files and application and restore them to their proper condition.” Col. 2, lines 44-46. The fact that Snow’s system can “automatically” detect damaged files does not mean that such detection is occurring continuously. “Automatically” means that this detection “act[] or operat[es] in a manner essentially independent of external influence or control”—*i.e.*, the user does not have to do anything to initiate this detection process. See [www.dictionary.com](http://www.dictionary.com) (definition of “automatic”). However, this does not mean that this detection is occurring continuously—*i.e.*, at all times. For example, Snow’s system could be set up so that this detection occurs automatically every time the computer is turned on or off. Such a detection method would clearly be automatic but would not be continuous.

such that there is no longer a conflict between the runtime representation and the pre-established working definitions. Col. 1, lines 61-64; Col. 10, lines 17-19.

Thus, while Snow may teach a system which monitors the application by comparing the runtime representation with the present definitions, there is nothing in Snow which suggests or teaches that this monitoring necessarily occurs by monitoring system calls in order to determine whether the system calls were properly executed. Likewise, there is absolutely nothing that indicates that the system calls are examined continuously to verify that these calls were executed properly. Both of these limitations are found in the claims and are not inherent or necessarily taught by Snow. Instead, the Examiner is simply asserting “probabilities or possibilities” which are, as a matter of law, insufficient to show inherent disclosure. *Robertson*, 169 F.3d at 745, 49 USPQ2d at 1950-51.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 14 and 23 are patentably distinct from the cited references. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 4-13, 31, and 34 depend either directly or indirectly from claim 1. Claims 17-22 and 32 depend either directly or indirectly from claim 14. Claims 24-30 and 33 depend either directly or indirectly from claim 23. Accordingly, Applicants respectfully request that the rejection of claims 4-13, 17-22, and 24-34 be withdrawn for at least the same reasons as those presented above in connection with claims 1, 14, and 23.

However, with particular reference to dependent claim 4, this claim recites the limitation that “a user... can initiate the repair mechanism.” There is no indication in the cited portion that any sort of user will initiate the repair. On the contrary, the cited portion of Snow (*i.e.*, col. 1, lines 28-31 and col. 2, lines 44-50) teaches that the detection and repair mechanism occurs “automatically”—*i.e.*, “independent of external influence or control” by a user. As such, this limitation is clearly not taught or suggested by the cited reference and withdrawal of this rejection is appropriate.

Finally, with respect to new claim 34, this claim includes the limitation of “determining when a previous attempt to repair the application was made.” Support for this limitation is found on page

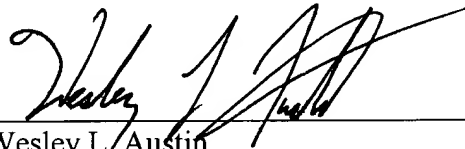
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18, lines 6-17 of Applicants' specification. Applicants can find no teaching or suggestion of this claim element anywhere in Snow's disclosure. Accordingly, as this claim limitation is not taught or suggested by the prior art, this claim is immediately allowable. Favorable consideration and allowance of this claim is respectfully requested.

III. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

  
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